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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/367,481 08/13/99 FUSHIKI

T 35859.1

EXAMINER

HM22/0628

INTELLECTUAL PROPERTY GROUP
GRAHAM & JAMES
885 THIRD AVENUE
NEW YORK NY 10022

COE.S

ART UNIT

PAPER NUMBER

1651

DATE MAILED:

06/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/367,481

Applicant(s)

Fushiki et al.

Examiner

Susan Coe

Group Art Unit

1651



☒ Responsive to communication(s) filed on Apr 11, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 24-39 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 24-39 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. The amendment filed April 11, 2000, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.
2. Claim 39 has been added.
4. Claims 24-39 are pending.

Claim Rejections - 35 USC § 103

5. Claims 24-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 3,764,692 in view of US Pat. No. 5,536,516 and McCarty (Medical Hypotheses (1995) Vol. 45, pages 247-254) for the reasons set forth on pages 6 and 7 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the disclosure by McCarty that (-)hydroxycitric acid consumption will prolong endurance during exercise is only an invitation to try using hydroxycitric acid for this purpose because the teaching by McCarty is an assumption that is not backed up by scientific evidence and that the conclusions of McCarty are proven wrong by Dohm. The examiner disagrees. The hypothesis set forth by McCarty is backed up by strong reasoning based on the literature in the art at the time the article was written. The teaching by McCarty provides a strong enough case for hydroxycitric acid increasing endurance that a person of ordinary skill in the art would have reasonably expected that hydroxycitric acid would increase endurance. Despite the fact that McCarty does not actually provide experimental evidence of this

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point is not considered an invitation to experiment because of the detailed analysis and reference support that is provided by McCarty. In regards to the conclusions set forth by Dohm, Dohm makes no mention of hydroxycitric acid in his experiment; therefore, this reference is not entirely pertinent to the matter at hand. Dohm does not set forth any data concerning hydroxycitric acid, so a person of ordinary skill would not be able to categorically conclude from Dohm that the hypothesis set forth by McCarty is incorrect.

Claims 32-39 have been amended to recite a method of administering a food composition containing hydroxycitric acid to increase endurance. These claims are rejected over US '692, US '516 and McCarty for the same reasons set forth for claims 24-31. US '692 is considered to teach administering hydroxycitric acid containing extracts of Garcinia in combination with substances that can be considered food. Thus, the combination of US '692, US '516 and McCarty is considered to teach administering hydroxycitric acid from Garcinia in the form of a food to increase endurance. While applicant has not seen this new grounds of rejection for claims 32-39, the arguments set forth by applicant will be answered to the point which they still apply. Regarding the teaching of US '692 to administer hydroxycitric acid from Garcinia in substances that can be considered food, applicant argues that US '693 administers the hydroxycitric acid in the form of pharmaceutical carriers such as tablets, capsules, and liquids that are not considered food. However, US '692 does teach administering the hydroxycitric acid with water and gelatin. Water and gelatin are clearly food items. Applicant also argues that food items are not acceptable pharmaceutical carriers; therefore, a person of ordinary skill in the art

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would not be motivated to administer hydroxycitric acid in the forms specified by applicant. US '692 clearly teaches that it is appropriate to administer hydroxycitric acid with substances that can be considered food, i.e. water and gelatin. With this teaching, a person of ordinary skill in the art would recognize that it is appropriate to administer hydroxycitric acid with oral carriers. The examiner disagrees with applicant's assertion that food is not considered a pharmaceutically acceptable carrier. It is extremely well known and well established in the art to mix a pharmaceutical with food in order to make the pharmaceutical more easy to administer and more palatable to the patient.

6. No claims are allowed.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 7:30 to 5:00 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SDC
June 22, 2000



FRANCISCO PRATS
PRIMARY EXAMINER